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10/775,091	02/11/2004	Koichiro Suzuki	03500.017904.	1187
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EXAMINER				
RODRIGUEZ, LENNIN R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,091

**Applicant(s)**

SUZUKI, KOICHIRO

**Examiner**

LENNIN R. RODRIGUEZ

**Art Unit**

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-12, 19-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 19-22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/03/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed on 11/19/2008 have been fully considered but they are not persuasive. Applicant's argument regarding "the apparatus of Claim 1 is not recited as having any means by which it could print ID information on a recording medium; rather, it reads the ID information from the RFID tag arranged on the recording medium in advance, so that the read ID information is stored in the database in association with the data subjected to the image forming operation" has been fully considered, in response: Mukai '329 discloses an image forming system comprising: detecting means that communicates with the recording medium and reads the identification information from the recording medium (column 6, lines 63-67, where the scanner detects the ID from the paper); Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag

that stores information; However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store information); Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

3. Applicant's argument regarding "Examiner's analysis and application of the prior art are correct in all respects, Applicant strongly believes that nothing in those documents could have led a person of merely ordinary skill to an apparatus having the database means recited in Claim 1, in which the database means is formed when the data is subjected to the image forming processing, thereby associating the ID information read from the RFID tag arranged on the recording medium with the data formed thereon" has been fully considered, in response: this claimed argument does not seem, to the examiner, to be present in the claim language or at least in the broadest reasonable interpretation of the claim language. Examiner's understanding of the claim language does not see the database being formed at the time of the printing operation, in the contrary it seems that a scanner is reading the RFID of the pages containing information and then printing the information on a new sheet of paper.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-4, 6-8, 10-12, 19-22, 24-26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) in view of Teraura (US 2002/01709730).

(1) regarding claims 1 and 19:

Mukai '329 discloses an image forming system comprising:

image forming means that forms an image relating to subject data on a recording medium that stores identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that communicates with the recording medium and reads the identification information from the recording medium (column 6, lines 63-67, where the scanner detects the ID from the paper);

database means (column 6, lines 56-58, database server) that, in accordance with an image forming operation for an image relating to desired subject data by the image forming means, stores first identification information, which is read by the detecting means from a first recording medium on which the image relating to the desired subject data is formed in the image forming operation (column 6, line 65 through column 7, line 7, where the database stores information about the identification of the

image data), and the desired subject data in association with each other (column 7, lines 2-7, printing data associated with the page ID);

retrieving means (scanner 400 in Fig. 1) that retrieves subject data corresponding to the first identification information read by the detecting means from the first recording medium on which the image relating to the desired subject data is formed (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server), from plural subject data stored in the database means from plural subject data stored in the database means, at a timing different from the image forming operation for the image relating to the desired subject data on the first recording medium (column 10, lines 34-41, where the scanner retrieves its information from the database server); and

control means that controls, in accordance with a result of the retrieval by the retrieving means, the image forming means to form an image relating to the subject data corresponding to the first identification information retrieved by the retrieving means on a second recording medium (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device).

Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag that stores information;

communicating with the RFID tag of the recording medium by a radio frequency communication and reading the identification information from the RFID tag; and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium.

However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store information);

communicating with the RFID tag of the recording medium by a radio frequency communication (paragraph [0060], lines 2-4) and reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15); and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium (A3 in Fig. 6 and paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper, thus this sheet of paper can be substituted by the sheet of paper used to print in Mukai '329).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

(2) regarding claims 2 and 20:

Mukai '329 further discloses storing means that stores the plural subject data (column 6, lines 52-55, external storage); and

selecting means that is capable of selecting the desired subject data from the plural subject data stored in the storing means (column 6, lines 65-67 and column 7, lines 1-7, where the information related to certain searched ID is retrieved).

(3) regarding claims 3, 7, 21 and 25:

Mukai '329 further discloses wherein at least a part of the image forming means, the detecting means, the storing means, the selecting means, the database means, and the retrieving means are connected via a network (column 6, lines 56-59).

(4) regarding claims 4 and 22:

Mukai '329 further discloses a detection unit in the vicinity of a moving path of the recording medium having in the image forming operation (page ID recognizer 71 in Fig. 1) and a recording medium brought close to the image forming means (column 10, lines 34-41, where a page is being brought to the scanner so that the ID information can be obtained).

Mukai '329 discloses all the subject matter as described above except wherein the detecting means includes a first detection unit for reading the information from the RFID tag of the recording medium in accordance with the image forming operation by the image forming means and a second detection unit for reading the information from the RFID tag of the recording medium at a timing different from the image forming operation by the image forming means, and

the first detection unit is provided in the vicinity of a moving path, and the second detection unit is provided at a position where the second detection unit can read out the identification information in the case where the recording medium is brought close.



However, Teraura '973 teaches wherein the detecting means includes a first detection unit for reading the information from the RFID tag of the recording medium in accordance with the image forming operation by the image forming means (paragraph [0072], where the reader-writer 15 reads information from the RFID tag) and a second detection unit for reading the information from the RFID tag of the recording medium at a timing different from the image forming operation by the image forming means (paragraph [0072], where the reader-writer 16 reads information from the RFID tag), and

the first detection unit is provided in the vicinity of a moving path (15 in Fig. 2), and the second detection unit is provided at a position where the second detection unit can read out the identification information in the case where the recording medium is brought close (16 in Fig. 2, where the papers can be brought near the document discharger and the reader-writer is capable of reading the RFID tag).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to detecting units for detection of identification information and that each of the detection devices are in different positions of the system as taught by Teraura '973 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the printer more efficient since it contains multiple places to perform the reading step thus making it user-friendlier.

(5) regarding claims 6 and 24:

Mukai '329 further discloses wherein the subject data includes image data (column 8, lines 57-61).

(6) regarding claims 8 and 26:

Mukai '329 further discloses wherein the database means further stores additional information, which is related to the image forming operation of the image of the subject data, in association with the subject data (column 6, lines 63-64 and column 7, lines 1-9, where the PDL data describes the original image, and the original image quality is ensured), and

the retrieving means retrieves the subject data corresponding to the additional information in the case where information identical with the additional information is inputted at a timing independent from the image forming operation (column 10, lines 34-41, where the scanner identifies another page ID (second identification information) and retrieves its information from the database server and column 7, lines 3-7, where if the scanned image is found in the external storage, the image just captured is discarded and instead the saved one is retrieved).

(7) regarding claims 10 and 28:

Mukai '329 further discloses wherein the database means further stores, in accordance with the image forming operation for the image of the retrieved subject data by the image forming means on the second recording medium, identification information (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server), which is read by the detecting means from the second recording medium on which the image relating to the retrieved subject data is to

be recorded (71 page ID recognizer Fig. 1), and the retrieved subject data in association with each other (column 10, lines 38-41, where the data retrieve is associated with the page ID).

Mukai '329 discloses all the subject matter as described above except specifically teaching reading information from the RFID tag;

However, Teraura '973 teaches reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15);

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

(8) regarding claims 11 and 29:

Mukai '329 further discloses an image forming system (Fig. 1) comprising:

image forming means that forms an image relating to subject data on a recording medium that stores identification information specific to the recording medium (column 4, lines 64-67 and column 5, lines 1-3, where the assigned page ID is printed on the page that would have the identification information);

detecting means that communicates with a recording medium on which an image is formed by the image forming means (column 6, lines 63-67, where the scanner detects the ID from the paper); and

control means that retrieves subject data corresponding to the identification information read from a first recording medium on which an image corresponding to the subject data is formed by the image forming means (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device), by the detecting means from plural subject data stored in a database that stores the identification information read from plural recording medium on which the images corresponding to the subject data is formed respectively (column 6, line 65 through column 7, line 7, where the database stores information about the identification of the image data) and the plural subject data in association with each other and controls the image forming means to form an image relating to the retrieved subject data on a second recording medium (column 10, lines 34-45, where the printing data retrieved is outputted to a printing device to be printed into another sheet of paper).

Mukai '329 discloses all the subject matter as described above except specifically teaching a recording medium having an RFID tag that stores information;

communicating with the RFID tag of the recording medium by a radio frequency communication and reading the identification information from the RFID tag; and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium.

However, Teraura '973 teaches a recording medium having an RFID tag that stores information (paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper and that the RFID also contains a memory to store information);

communicating with the RFID tag of the recording medium by a radio frequency communication (paragraph [0060], lines 2-4) and reading information from the RFID tag (paragraph [0071], lines 3-6, reader-writer 15); and

the image forming means to form an image on a second recording medium already having the RFID tag different from the first recording medium (A3 in Fig. 6 and paragraph [0060], lines 9-10 and paragraph [0062], where it teaches that the RFID is contained in a sheet of paper, thus this sheet of paper can be substituted by the sheet of paper used to print in Mukai '329).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the holding means includes an RFID tag as taught by Teraura '730 in the system of Mukai '329. It is required to store digital data readable by a computer together with visual data, i.e., characters, figures, and photo image in the same medium or a combined medium (paragraph [0004]), making the recording medium more efficient since it contains multiple information thus using less resources.

(9) regarding claims 12 and 30:

Mukai '329 further discloses wherein the control means includes retrieving means that retrieves the subject data corresponding to the identification information, which is detected by the detecting means, from plural subject data stored in storing means (column 10, lines 34-41, where the scanner identifies a page ID and retrieves its information from the database server).

6. Claims 9 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukai (US 6,466,329) and Teraura (US 2002/01709730) as applied to claims above, and further in view of Bontempi (US 2003/0137689).

(1) regarding claims 9 and 27:

Mukai '329 and Teraura '973 disclose all the subject matter as described above except wherein the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data.

However, Bontempi '689 teaches wherein the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data (paragraph [0033], where the information received includes printer identification field and a printer driver which executed the image forming operation).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the additional information includes identification information of an apparatus and application software which executed the image forming operation for the image of the subject data as taught by Bontempi '689 in the system of Mukai '329 and Teraura '973. This enhances the capabilities of the system by allowing it to specify which printer and which software to use for the creation of the image print out.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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